

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Matthew J. WAGNER, et. al. Confirmation No.: 1613
Application Serial No.: 10/780,397
Filed: February 17, 2004
Title: COMPUTER SECURITY SYSTEM AND METHOD
Group Art Unit: 2115
Examiner: Abbaszadeh, Jaweed A.
Docket No.: 200314073-1

Mail Stop: **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The final Office Action mailed June 25, 2008 has been carefully considered. Claims 1-46 remain pending. Please consider the following remarks.

REMARKS

I. REJECTIONS UNDER 35 U.S.C. §102 IS IMPROPER

The Examiner indicated that Claims 1-46 stand rejected under 35 U.S.C. §102(e) as being anticipated by Publication No. 2005/0125698 issued to *Yeates* et al. (hereinafter "*Yeates*"). Applicant respectfully maintains that the use of *Yeates* is improper for rejecting the pending claims as *Yeates* does not qualify as prior art under 35 U.S.C. §102(e). Therefore, Applicant respectfully requests that the rejection in view of *Yeates* be withdrawn.

II. APPLICANTS' DECLARATIONS UNDER 37 C.F.R. §1.131 ARE EFFECTIVE

In the final Office Action mailed June 25, 2008, the Examiner indicated that the Declarations filed on March 12, 2008 were considered but deemed ineffective for overcoming the 35 U.S.C. § 102(e) rejection of Claims 1-46 of the present Application over *Yeates*. Applicants respectfully traverse. In particular, the Examiner asserts that Applicants' Declarations are ineffective because the evidence submitted therewith is insufficient to establish conception of the invention as claimed by Applicants. (Office Action dated June 25, 2008, pages 2-3). Specifically, the Examiner states:

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

(*Id.*).

The invention disclosure form submitted with the Declarations of Matthew J. Wagner (hereinafter "the Wagner Declaration") and Valiuddin Ali (hereinafter "the Ali Declaration") as proof of conception of the invention prior to the purported effective date of *Yeates* clearly indicates a computer security system having a "self-managed device having an authentication system for controlling access to the self-managed device by a user" and "a security module adapted to authenticate an identify of the user and, in response to user authentication,

automatically generate, transparently to the user, device credential data verifiable by the authentication system to enable user access to the self-managed device” as recited, for example, by Claim 1. MPEP 715 states:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

(MPEP 715) (emphasis added). In accordance with the MPEP, Applicants respectfully submit that the Wagner and Ali Declarations and supporting evidence establish that the subject matter of the rejected claim(s) was conceived prior to the effective date of the *Yeates* reference. For example, the invention disclosure form submitted as an exhibit to the Wagner and Ali Declarations recites:

- Once invoked the computer system automatically generates a strong password that can conform to specific password security policy using any number of techniques involving hardware or software. It is envisioned that actual implementations will involve generating a random password, encryption key or other credential; however, the exact method of creating the password is implementation specific.
- The computer system BIOS would then enable password protection for the device using the created password. The computer system would then destroy the clear text password from all accessible memory ensuring no unauthorized access.
- When access to the protected device is required, the security subsystem would first authenticate the user or other requestor. Successful authentication would then allow the above-created password to be decrypted and used to access the protected device.

(see page 4 of Exhibit A of the Wagner and Ali Declarations) (emphasis added). Therefore, Applicants respectfully submit that the description presented in the invention disclosure form is more than a vague idea and clearly meets the requirements established by the MPEP to establish conception of the subject matter of the rejected claim(s). Accordingly, Applicants submit that the Examiner's finding that Applicants' Declarations are ineffective to overcome the *Yeates* reference is improper and should be withdrawn.

CONCLUSION

Accompanying this Request is a Notice of Appeal pursuant to 37 C.F.R. 41.31. The Commissioner is hereby authorized to charge the sum of \$510.00 for the Notice of Appeal to Deposit Account No. 08-2025 of Hewlett-Packard Company. No further fee is believed due with this Request. If, however, Applicant has overlooked the need for any other fee due with this Request, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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